

## **REMARKS**

### **A. 35 U.S.C. § 102**

In the Office Action of April 1, 2004, claims 11 and 15 were objected for several informalities. For example, claim 11 was objected to for not having proper antecedent basis for the phrase “the setting.” Claim 11 has been amended so as to depend from claim 3 which does recite a setting process. Since there is proper antecedent basis for the phrase in question, the objection has been overcome and should be withdrawn.

Claim 15 was objected to for not having proper antecedent basis for the phrase “the spacing.” Claim 15 has been amended so as to replace the offending phrase with “a spacing.” Since there is no antecedent basis issue with the amended phrase, the objection has been overcome and should be withdrawn.

### **B. 35 U.S.C. § 102**

#### **1. Claims 2, 4-7, 10-12, 16-23 and 36**

Claims 2, 4-7, 10-12, 16-23 and 36 were rejected under 35 U.S.C. §102(b) as being anticipated by Curtis.<sup>1</sup> Claim 2 has been canceled rendering its rejection moot. Regarding the remaining claims, claims 4-7, 9-12, 17-19, 21, 22 and 36 have been

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<sup>1</sup> It is noted that page 2 of the Office Action states that claim 15 is anticipated by Curtis. However, pages 1 and 7 of the Office Action state that claim 15 contains allowable subject matter. Furthermore, the text of the Curtis rejection does not mention claim 15 at all. Accordingly, Applicants will assume that the recitation of claim 15 on page 2 was in error.

amended so as to depend directly on allowed claims 3 or 15. Accordingly, claims 2, 4-7, 10-12, 16-23 and 36 are allowable for at least the same reasons that their corresponding independent claims 3 and 15 are allowable. Thus, the rejection has been overcome and should be withdrawn.

As mentioned above, claims 4-7, 9-12, 17-19, 21, 22 and 36 have been amended so as to depend from either claim 3 or 15 and are being presented to provide additional coverage for either the method for operation of a position measuring device as recited in claim 3 or the position measuring device of claim 15. Accordingly, the amendments of claims 4-7, 9-12, 17-19, 21, 22 and 36 are not being presented for reasons of patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002).

## **2. Claim 35**

Claim 35 was rejected under 35 U.S.C. §102(b) as being anticipated by Curtis. Applicant traverses this rejection for several reasons. First, the rejection fails to specify what portions of Curtis anticipate the various processes recited in claim 35. This is unfair to the Applicant since it leaves it to him to guess the basis for the rejection. Accordingly, Applicant requests a more detailed analysis in the next Office Action if the rejection is repeated.

The rejection is improper for the additional reason in that Curtis fails to disclose transmitting a digital signal in a defined serial transmission protocol. Despite the improperness of the rejection, claim 35 has been amended to clarify that the “transmitted digital signal is transmitted with a predetermined bit width.” Curtis does not disclose transmitting a digital signal in a defined serial transmission protocol and with a predetermined bit width to an evaluation unit. Accordingly, claim 35 is not anticipated by Curtis and the rejection should be withdrawn.

Besides not being anticipated by Curtis, claim 35 is not rendered obvious by Curtis. In particular, there is no suggestion or motivation in Curtis or the prior art to alter Curtis to transmit digital signal with a defined serial transmission protocol and that is transmitted with a predetermined bit width to an evaluation unit. Without such motivation, claim 35 is patentable over Curtis.

Please note that claim 35 has been amended so as to be in independent form. Since the amendment incorporates subject matter that was inherently present in claim 2 and 35, the amendment is not being presented for reasons of patentability as defined in *Festo*.

C. **35 U.S.C. §103**

Claim 9 was rejected under 35 U.S.C. §103 as being obvious in view of Curtis. Claim 9 has been amended so as to depend directly on allowed claim 3. Accordingly,

claim 9 is allowable for at least the same reasons that independent claim 3 is allowable.

Thus, the rejection has been overcome and should be withdrawn.

Claim 9 has been amended so as to depend from claim 3 and is being presented to provide additional coverage for the method for operation of a position measuring device as recited in claim 3. Accordingly, the amendment of claim 9 is not being presented for reasons of patentability as defined in *Festo*.

**D. Claims 25-36**

Applicant notes with appreciation that claims 25-36 have been allowed.

**E. Claims 3, 8 and 15**

Applicant notes with appreciation that claims 3, 8 and 15 have been deemed to contain allowable subject matter.

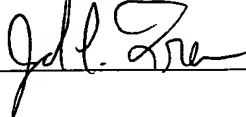
Claims 3 and 15 have been amended so as to be in independent form. Since the amendments incorporate subject matter that was inherently present in claims 3 and 15, the amendments are not being presented for reasons of patentability as defined in *Festo*.

**CONCLUSION**

In view of the arguments above, Applicant respectfully submits that all of the pending claims 3-12, 15, 17-23 and 25-36 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any

remaining issues, he is respectfully requested to contact the undersigned attorneys at  
(312) 321-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John C. Freeman", is written over a horizontal line.

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